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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,124	10/21/2003	Mark M. Mangerson	P1629US01	3656
32709	7590	10/26/2007		
Gateway Inc Patent Attorney PO Box 2000 N. Sioux City, SD 57049			EXAMINER LEE, CHEUKFAN	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 10/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/690,124

Applicant(s)

MANGERSON, MARK M.

Examiner

Cheukfan Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/5/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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1. Claims 1-24 are pending. Claims 1, 15 and 21 are independent.

Originally, claims 1-11 and 13-25 were presented for examination, with no claim

12. Claims 1-11 and 13-25 have been renumbered to claims 1-24, respectively. The claim numbers in the dependent claims have also been changed accordingly, i.e., the dependency of the claims have been changed accordingly.

Please use the claim numbers as renumbered in future amendments and/or response.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,661,542.

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Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons given below.

Claim 1 claims the limitations of patent claim 1, except that claim 1 recites "one of reflected from and transmitted through the object" in place of the patent claim 1 limitation "reflected from the object". One of ordinary skill in the art would have realized that when an original is a transparent original, the scanner requires backlighting, i.e., a light source is required to be positioned such that the transparent original is sandwiched between the light source device and the image sensor. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a light source at a position such that the original is sandwiched between the light source and the shutter assembly to enable scanning a transparent original.

Claims 2 and 3 claim the limitations of patent claims 2 and 3, respectively.

Claim 4, which is understood to include the limitations of claim 1, is rejected as being unpatentable over patent claim 1 because, based on the discussion for and reason of obviousness given for claim 1, one of ordinary skill in the art would have realized that the backlighting required for scanning a transparent original as discussed above for claim 1, is produced by a backlighting light source. Therefore, based on the discussion for and the reason of obviousness given for claim 1, employing a

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backlighting light source to illuminate the transparent original would have been obvious to one of ordinary skill in the art at the time the invention was made.

Claim 5 corresponds to patent claim 4. Claim 5 recites "conducting light reflected from or transmitted through the object", while patent claim 4 recites "conducting light reflected from the object". Such difference in limitations is discussed above for claim 1. Please refer to the discussion for and the reason of obviousness given for claim 1.

The claim 6 limitation is anticipated by patent claim 5. See lines 1-4 of patent claim 5.

Claim 7 corresponds to patent claim 5. Please note that "a light source for generating high intensity pulses of light" of lines 1-2 of claim 7 corresponds to "said pulses of light" of lines 6-7 of patent claim 5 ("said pulses of light" in patent claim 5 lacks antecedent basis due to the inadvertent error made by the examiner at the time the patent was issued. Please refer to "a light source" of patent claim 2). The limitation "said pulses of light" of patent claim 5 is understood to mean high intensity pulses of light generated by a light source.

Claim 8 corresponds to patent claim 6. Please note the "a strobe light source for generating high intensity pulses of light" of lines 1-2 of claim 8 corresponds to "said pulses of light" of line 5 of patent claim 6 ("said pulses of light" in patent claim 6 is understood to mean the pulses of light generated by a strobe light source. Please refer to "a strobe light source" of patent claim 3).

Claims 9-14 (12-13 being the claim numbers after the renumbering according to section 1 above) corresponds to patent claims 7-12, respectively.

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Independent claim 15 (15 being a renumbered claim number) corresponds to patent claim 13. Claim 15 recites "a plurality of optical sensors", whereas patent claim 13 recites "an optical sensor". Another difference between claim 15 and patent claim 13 is that claim 15 claims "light transmitted through the object" as opposed to "light reflected from the object". As discussed above for claim 1, one of ordinary skill in the art would have realized that when an original is a transparent original, the scanner requires backlighting, i.e., a light source is required to be positioned such that the transparent original is sandwiched between the light source device and the image sensor. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the light source of patent claim 13 with a light source at a position such that the original is sandwiched between the light source and the shutter assembly to enable scanning a transparent original.

With respect to the difference between the "plurality of optical sensors" of claim 15 and the "optical sensor" of patent claim 13, one of ordinary skill in the art would have realized that a plurality of optical sensors, instead of an optical sensor, are employed for generating color image data of color components such as red, blue and green. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a plurality of optical sensors instead of an optical sensor of patent claim 13, in order to generate color image data from the original.

The limitation of claim 16 (16 being a claim number after the renumbering) is anticipated by patent claim 14.

Claim 17 (17 being a claim number after the renumbering) corresponds to patent claim 21.

Claim 18 (18 being a claim number after the renumbering) depends on claim 15. Claim 18 is understood to include all limitations of claim 15. Claim 18 recites "wherein said optical sensor comprises a color image sensor having red, blue and green sensing elements for sensing red, blue and green light". Based on the discussion for and the reason of obviousness with respect to optical sensors employed to generate color image data having the color components red, blue and green, employing an optical sensor comprising a color image sensor having red, blue and green sensing elements for sensing red, blue and green light would have been obvious to one of ordinary skill in the art.

Claims 19 and 20 (after the renumbering) correspond to patent claims 15 and 16, respectively.

Independent claim 21 claims a broader version of claim 1. Claim 22 is rejected as being unpatentable over U.S. Patent No. 6,661,542 for the reasons given for claim 1. Please refer to the discussion for claim 1.

Claims 22-24 claim broader versions of claims 2, 4 and 5, respectively, and therefore are rejected for the reasons given for claims 2, 4 and 5.

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (571) 272-7407. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cheukfan Lee
August 28, 2007